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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,335	09/16/2003	Ann Marie Madera	R0142B-REG	3782
24372	7590	05/09/2006	EXAMINER	
ROCHE PALO ALTO LLC PATENT LAW DEPT. M/S A2-250 3431 HILLVIEW AVENUE PALO ALTO, CA 94304			WARD, PAUL V	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/663,335

Applicant(s)

MADERA ET AL.

Examiner

PAUL V. WARD

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 21,22 and 24-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. The provisional application, 60/411,480 upon which priority is claimed provides adequate support under 35 U.S.C. 112 for claims 1-27 of this application. Thus, the effective filing date of this application is September 17, 2002.

### ***Election/Restrictions***

Applicant's election without traverse of Group I in the reply filed on January 18, 2006 is acknowledged.

Applicant is entitled to have the method claims (Groups III and V), which are commensurate in scope with the elected invention, rejoined if the compounds in Group I are allowed. An amendment, which results in the method claims being commensurate in scope with the allowed claims, will be welcomed.

Groups II-VI are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant reserved the right to file a divisional application to the non-elected subject matter.

An action on the merits of Group I (claims 1-20 and 23) is contained herein.

### ***Claim Objections***

Claims 11 and 14 objected to because of the following informalities:  
In claim 11, the conjunction "or" should be added following the term "halo,".

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Claim 14 does not end with a period. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

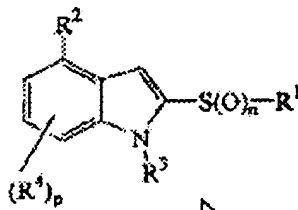
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Macor et al. (WO 96/03400).

Applicant teaches indole compounds as serotonin agonists and antagonists for treating various diseases. Applicant claims a compound with a general formula I:



wherein all the variables are as defined in the claim. Additionally, Applicant claims a composition comprising a therapeutically effective amount of the compound of formula I, and a pharmaceutically acceptable carrier.

Macor discloses indole compounds, which share the same formulaic compounds. (See formula 1, Abstract). The compounds in the said reference has the same structure, which includes n as 0, 1 or 2, R<sup>1</sup> as an aryl group, R<sup>2</sup> as heterocyclyl, R<sup>3</sup> as hydrogen, alkyl, or -C(=O)-R<sup>5</sup>, and R<sup>4</sup> as hydrogen, and falls within the range of Applicant's indole compounds. (See pages 3-5). Additionally, on page 5, lines 17-20,

Macor discloses pharmaceutical compositions comprising a therapeutically effective amount of the compound of formula I, and pharmaceutically acceptable carriers. Since Macor teaches the exact compounds and compositions, Applicant's claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macor et al. (WO 96/03400).

Macor teaches a generic group of indole derivatives, which embraces Applicant's claimed compounds. (See formula 1 page 3, and definitions for X, R<sup>1</sup>, R<sup>2</sup> and R<sup>3</sup>). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to

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render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

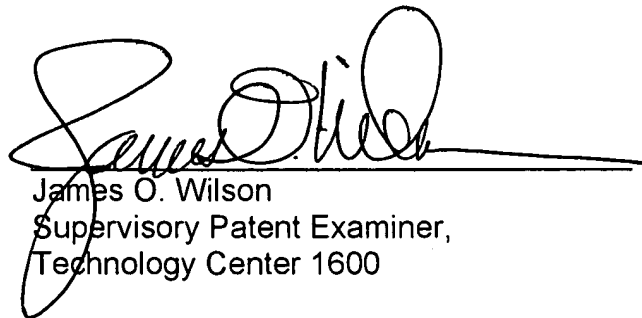
**Conclusion**

Claims 1-20 and 23 are pending. Claims 1-20 and 23 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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